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10/840,041	05/06/2004	Fabrizio Alessandro Maspero	1032553-000059	7765

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EXAMINER

RAMANA, ANURADHA

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3733

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn et al. (US 5,702,716).

Dunn et al. disclose a moldable implant composition including: a plurality of biocompatible granules such as ceramics or calcium phosphate; a biocompatible polymer such as polylactide or polycaprolactone; a plasticizer such as N-methyl-2-pyrrolidine or acetone; and a biologically active substance such as a growth factor wherein the composition can be delivered by injection or preformed as an implant for surgical insertion (col. 3, lines 33-67, cols. 4-13 and col. 14, lines 1-45).

Claims 1-16, 41, 43, 44 and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Evans et al. (US 7,241,316).

Evans et al. disclose a moldable implant composition including: a plurality of biocompatible nanoparticles or "granules" such as ceramics or calcium phosphate; a biocompatible polymer such as polylactide or polycaprolactone; a plasticizer such as caprolactone; and a biologically active substance such as a growth factor wherein the composition can be delivered by injection or preformed as an implant for surgical insertion (Figs. 15-18, col. 16, lines 20-61, col. 18, lines 63-67, col. 19 and col. 20, lines 1-51).

Regarding claim 16, Evans et al. also disclose the use of a syringe to inject the implant material (col. 22, lines 55-62 and col. 24).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al. (US 7,241,316).

Evans et al. disclose all elements of the claimed invention except for the claimed weight percentages.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided claimed weight percentages of biocompatible polymer, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response filed on January 18, 2008 have been fully considered but are not persuasive for the following reasons.

Dunn et al. clearly disclose a moldable implant composition containing synthetic non-polymeric granules. Dunn et al. disclose that a solid implantable polymer system could be formed outside the body by molding and then surgically placed into the body (col. 2, lines 31-41 and lines 65-67 and col. 3, lines 1-4). It is the Examiner's position that Dunn et al. disclose the use of synthetic non-polymeric materials such as

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hydroxyapatite, in granular form, to form a dispersion in the polymer (i.e., fine particles or granules in polymer).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
May 27, 2008

/Anu Ramana/
Primary Examiner, Art Unit 3733